

R E M A R K S

By the above-identified office action, claims 1-12 and 14-19 were rejected under 35 USC 103 as obvious over Smith in view of Kramer, citing Smith for all features of the claimed combinations as a whole of the independent claims 1, 5, 10, 14, 15 and 17 of the instant invention, except for a collectible sound card, and further citing Kramer for such a collectible sound card, "Kramer teaches that it has been well-known in the art to to [sic] provide a system which can provide extra sound entertainment from a collectible sound card; see page 3." By the instant amendment, the 103 rejection of claims 1-12 and 14-19 over Smith in view of Kramer is respectfully traversed, and it is respectfully submitted that the claimed combinations as a whole of the independent claims 1, 5, 10, 14, 15 and 17 represent a non-obvious patentable advance over the art of the combination rejection of record.

The programmable bubble memory card for a mere sound reproduction unit that only reproduces the sounds programmed on the programmable bubble memory card of Kramer does not teach, or suggest, a collectible sound card having prerecorded sounds operative to add its sounds to built-in sounds of a sound replay unit in order to customize the library of sounds to individual taste as in the present invention, and there is no objective reason, either express or by necessary implication, which would motivate one of skill in the art to combine the programmable bubble memory card of Kramer with the method and apparatus for enhancing electronically

generated sound of Smith to provide the claimed combinations as a whole of the independent claims of the present invention.

Kramer discloses a programmable memory card and sound reproduction unit cooperative to play only the sounds programmed on the programmable memory card. Absent such a programmable memory card, the sound reproduction unit itself simply has no sounds to replay. Since the programmable bubble memory sounds are the only sounds available for replay, and because the sound reproduction unit absent the programmable bubble memory has no sounds to play, there therefore are no built-in sounds for the sound reproduction unit to replay, and the programmable bubble memory card therefore does not teach or suggest making its sounds available for replay in addition to built-in sounds.

There therefore is no objective evidence, either explicit or by necessary implication, which would motivate one of skill in the art to combine the Kramer programmable bubble memory card with the Smith method and apparatus for enhancing electronically generated sound to provide the collectible sound card having prerecorded sounds operative to add its sounds to built-in sounds of a sound replay unit in order to customize the library of sounds to individual taste as in the claimed combinations as a whole of the independent claims 1, 5, 10, 14, 15 and 17 of the present invention. Since, therefore, motivation for the combination lies in impermissible hindsight rather than objective evidence, the 103 rejection of the claimed combinations as a whole of the independent claims of the instant invention must be respectfully traversed.

08/706,136
Second Amendment
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"The mere fact that the prior art could be modified in the manner proposed by the examiner would not have made the modification obvious unless the prior art suggested the desirability of the modification," Ex parte Dussand, 7 USPQ 2d 1818, 1820 (Bd. Pat. app. & Int'l. 1988), but because there is no such objective reason, either explicit or by necessary implication, the inventions of the claimed combinations as a whole of the independent claims of the present invention are non-obvious over the art of the combination rejection of record rather than being taught or suggested thereby. A courtesy copy of Ex parte Dussand is enclosed.

Reconsideration and withdrawal of the 103 rejection accordingly are hereby earnestly solicited.

Enclosed herewith is a copy of the declaration of Mr. Troy Anderson, which is believed to establish a nexus between the inventive aspects of the claimed combinations as a whole of the above-captioned invention and the commercial success of products embodying the present invention, and is hereby resubmitted as secondary considerations of the non-obviousness of the present invention (it was originally submitted as part of the CPA application and Preliminary Amendment filed 12/17/1998, and resubmitted with the Amendment filed 02/11/2000).

As evidenced by paragraph 1 thereof, Mr. Anderson has a masters degree in business, is a co-inventor of the above-captioned invention, and is Vice President of Headwaters Research & Development, Inc., the owner of the above-captioned invention.

As evidenced by paragraph 2 thereof, as Vice President of Headwaters Research & Development, Inc., among other things, he is responsible for selling and marketing new products

for world markets and for evaluating consumer responses to the products developed in order to monitor product acceptance and insure present and future consumer satisfaction.

As evidenced by paragraph 3 thereof, digital sound relaxation and noise masking devices represent a unique category of consumer products that are designed to alleviate stress and to promote a state of relaxation and calm.

As evidenced by paragraph 4 thereof, these devices simulate a natural or other sound environment that masks noise and soothes the listener without disrupting pauses.

As evidenced by paragraph 5 thereof, due to stress and noise not uncommon in modern Western societies, there is a considerable need for such devices.

As evidenced by paragraph 6 thereof, the present United States market for such devices is estimated at about 60 million dollars annually, which is expected to grow at a per annum rate of about 30 percent.

As evidenced by paragraph 7 thereof, the above-captioned invention is drawn to improved-customizability digital sound relaxation and noise masking devices that permit customers to customize the library of available sounds to their individual tastes and personal preferences by collecting collectible sound cards.

As evidenced by paragraph 8 thereof, in one of its inventive aspects, the claimed combinations as a whole of the independent claims 1 and 14 of the above-captioned invention call for, among other things, a collectible sound card, and a digital sound relaxation and noise masking device, cooperative therewith, in another of its inventive aspects, the claimed combinations as a

whole of the independent claims 5 and 15 call for, among other things, a digital sound relaxation and noise masking device adapted to mate with a collectible sound card, and in another of its inventive aspects, the claimed combinations as a whole of the independent claims 10 and 17 call for, among other things, a collectible sound card for use with a digital sound relaxation and noise masking device.

As evidenced by paragraph 9 thereof, Headwaters Research & Development, Inc. and its affiliates ("Headwaters") currently markets four (4) collectible sound cards as detailed in Attachment "A" thereto.

As evidenced by paragraph 10 thereof, Headwaters sells under its Tranquil Moments® marks a line of commercially successful improved-customizability digital sound relaxation and noise masking devices in accord with the above-captioned invention, which have received consumer acceptance to the amount of about 10 million dollars per annum, which is about 17 percent of the estimated present annual United States market for digital sound relaxation and noise masking devices.

As evidenced by paragraph 11 thereof, Headwaters includes an owner's reply card with each improved-customizability digital sound relaxation and noise masking device in accord with the above-captioned invention sold under the Tranquil Moments® marks, and compiles information from those that are returned as well as from sales and other data.

As evidenced by paragraph 12 thereof, consumer feedback to the Tranquil Moments® products has indicated the first importance of sound variety to owners of improved-customizability

digital sound relaxation and noise masking systems of the embodiment of Figures 1-7 in accord with the present invention as detailed in Attachment "B" thereto, which shows a bar chart compiled from 228 owner's reply cards from the years 1996-1997.

As evidenced by paragraph 13 thereof, the first importance of sound variety is believed on the one hand to be due to owner's different tastes in sounds. For example, one owner of a digital sound relaxation and noise masking device may prefer the sound of Rain Falling on a Tin Roof because it reminds them of similar cozy, rainy nights as a child, while another owner may prefer the sounds of Ocean Surf with Seagulls, because it reminds them of their of their favorite Hawaiian vacation. Since the heretofore known digital sound relaxation and noise masking devices only included a limited selection of built-in sounds, the collectible sound cards of the improved-customizability digital sound relaxation and noise masking devices of the present invention provide customers with an expanded selection of sounds from which to choose, thereby increasing the probability that owners can find their ideal sound(s).

As evidenced by paragraph 14 thereof, the first importance of sound variety is believed on the other hand to be due to owner's different use situations and different moods. It is known that a large percentage of digital sound relaxation and noise masking device owners alternate between available sounds. Some do this for variety, others do it to suit different use situations or moods. For example, some owners may prefer a good noise blocking sound like a Waterfall for use at the office, while at home they may prefer the gentler Rain sound for relaxation. The collectible sound cards of the improved-customizability digital sound relaxation and noise masking devices in accord

with the present invention provide a much larger repertoire from which users can find satisfactory sounds to fit the usage situation and prevailing mood.

As evidenced by paragraph 15 thereof, both to accommodate individual user's different tastes in sounds and to accommodate different use situations and changing moods, the inventive aspects of the claimed combinations as a whole in accord with the improved-customizability digital sound relaxation and noise masking devices of the present invention help satisfy what consumer response has indicated as the first importance of sound variety to owner's of digital sound relaxation and noise masking devices.

As evidenced by paragraph 16 thereof, five (5) representative owner's reply cards attached as Attachment "C" thereto detail the general importance of digital sound relaxation and noise masking devices to individual owners of improved-customizability digital sound relaxation and noise masking devices in accord with the present invention, and five (5) representative owner's reply cards attached as attachment "D" thereto detail the specific importance of the inventive aspects of the claimed combinations as a whole of the improved-customizability digital sound relaxation and noise masking devices in accord with the present invention.

As evidenced by paragraph 17 thereof, moreover, consumer response has indicated that two (2) out of three (3) owners of digital sound relaxation and noise masking devices traded under the Tranquil Moments® marks purchase at least one collectible sound card as detailed in Attachment "E" thereto, which shows a pie chart compiled from sales data for improved-

customizability digital sound relaxation and noise masking devices in accord with the present invention for the years 1996-1997.

As evidenced by paragraph 18 thereof, since the devices adapted to mate with collectable sound cards sold under the Tranquil Moments® marks in accord with the above-captioned invention are not sold with collectable sound cards, the fact that the overwhelming majority of owners of these devices go on to purchase one or more collectable sound cards, which are individually packaged and separately sold, underscores that the inventive aspects of the claimed combinations as a whole of the present invention are a principal factor motivating the commercial success of the Tranquil Moments® products in accord with the above-captioned invention.

Since for the forgoing reasons the independent claims 1, 5, 10, 14, 15, and 17 are now believed to be in allowable condition, the dependent claims 2-4, 6-9, 11, 12, 16, 18, and 19 are also in allowable condition, and need not be further discussed.

It should be noted, however, that the recited "sound bite" format of claims 8-9, 11-12 and 19 is not so indefinitely recited as to be "well-known" for which official notice is proper, but rather the recited "sound bite" format of claims 8-9, 11-12 definitely calls for at least two groups of addressable memory locations each storing different, self-contained and complete-in-themselves versions of the same sound, which, as recited in dependent claim 19, are randomly selected and played back at random times, whereby perception of annoying sound repetition is avoided and better reproduction of intermittent-type natural or other sounds than heretofore thought possible is achieved. As such, the limitations of the dependent claims 8-9, 11-12 and 19 are not believed

to recite "facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-know' in the art" (MPEP 2144.03), and in view of the traversal thereof, the examiner is invited to "cite a reference in support of his or her position" (MPEP 2144.03).

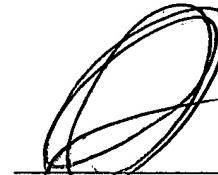
Reconsideration, reexamination and early allowance of claims 1-12, and 14-19 are, for the foregoing reasons, hereby respectfully requested.

The applicants appreciate the careful review of the above-captioned invention and respectfully invite the examiner to telephone or otherwise contact their undersigned representative to facilitate the further prosecution of the present invention.

Respectfully submitted,

Rudy Vandenberg et al.

By:

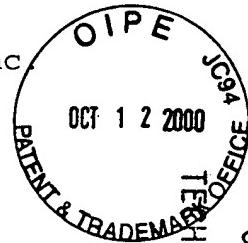


Albert Peter Durigon
Registration No. 30,049
Attorney for Applicants

Law Office of A. P. Durigon
20 Eustis Street
Cambridge, Massachusetts 02140
617-354-7330 (Telephone)
617-497-0229 (Telecopier)
Durigon@MediaOne.net (e-mail)

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1988 WL 252372 (Bd.Pat.App & Interf.)
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Ex parte Dussaud

Patent and Trademark Office Board of Patent Appeals and
Interferences

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United States Patents Quarterly Headnotes

PATENTS

[1] Practice and procedure in U.S. Patent and Trademark Office -- Declaration/Affidavits (§ 110.0913)

Examiner improperly held that declaration, which stated why artisan would not look to carpet manufacturing process and equipment field to solve problem in application of elastic to web in curvilinear pattern, was not persuasive on issue of whether particular reference constituted analogous prior art, since holding is improperly grounded on fact that declarant, though skilled in art of diaper manufacturing, is not expert on carpet making, and since examiner thus did not accord fair evidentiary weight to declarant's skepticism.

PATENTS

[2] Patentability/Validity -- Obviousness -- Relevant prior art (§ 115.0903)

Examiner's characterization of problem addressed by applicants' claimed method of attaching elastic to disposable diapers as "the laminating of continuous running sheets utilizing a hot melt adhesive" was broader than particular problem actually addressed by applicants, and resulted in consideration of prior art that is not truly analogous.

PATENTS

[3] Patentability/Validity -- Obviousness -- Combining references (§ 115.0905)

Examiner erred in holding that applicants' invention was obvious in view of two prior art references in combination, since there is no express or implied suggestion in teachings of two references which would have motivated person of ordinary skill in art to combine them in manner proposed by examiner.

*1818 Appeal from decision of Jerome Massey, primary examiner.

Patent application of Jacques Dussaud and Raphael De Jonckheere, serial no. 605,970, filed May 1, 1984. From decision refusing allowance of claims 10 through 18 and 21, applicants appeal. Reversed.

I. William Millen and Millen & White, Arlington, Va., for applicants.

Before Milestone, Winters, and Skinner, examiners-in-chief.

Winters, examiner-in-chief.

Appeal from the examiner's decision refusing to allow claims 10 through 18 and 21, which are all the claims remaining in this application.

Claim 10 is representative:

10. A method of continuously attaching an elongated narrow elastic element to a moving flexible sheet material to be employed as an outer moisture impermeable envelope for receiving an absorbent pad of a disposable diaper, said elastic element fitting in a stretched condition substantially along a curvilinear-shaped-cut-out of said envelope to allow a leg therethrough when said envelope is constructed as a diaper, said method comprising the steps of:

- (a) passing an elongated narrow elastic element, along a longitudinal path of travel, in a stretched condition;
- (b) intermittently depositing liquid adhesive material at high temperature on said elastic element during said passing step (a);
- (c) passing said elastic element, with adhesive material thereon, over a fixed guide means;
- (d) passing said elastic element with adhesive material over a carriage means, arranged down-stream of the fixed guide means in the direction of travel, and capable of being moved intermittently in a transverse direction;
- (e) feeding said flexible sheet around the peripheral surface of a rotary drum such that the sheet remains in contact with said drum for about one-half the rotation of said drum, said drum having a smooth outer surface which is maintained at a substantially constant temperature, said temperature being less than the temperature of said liquid adhesive, the difference between the temperature of the adhesive at the time of contact with said flexible sheet and the temperature of said peripheral surface of the drum being at least 20 degreesC; and
- (f) positioning said movable carriage immediately next to the

periphery of said *1819 rotary drum at a location such that said carriage means and said drum are not in contact with each other and such that the adhesive coated elastic element contacts said flexible sheet supported by said drum, and said sheet together with said elastic element remain in contact with said drum for at least a portion of the rotation of said rotary drum before leaving it, moving said carriage means intermittently in a direction transverse to the direction of rotation of said drum whereby said elastic element is laid-down on said drum in an oscillating path, and whereby said elastic element is intermittently attached in a stretched condition along a curved-shaped line only by laying said elastic element on said flexible sheet due to the temperature difference between the drum and the adhesive material;

and with the provision that steps (e) and (f) are conducted on a single drum and said temperature difference is sufficient to lead to an immediate adhesion effect capable of withstanding the transverse forces to which said elastic element is subjected owing to the movement of said carriage means.

The prior art references relied on by the examiner are:

Penman	3,150,023	Sep. 22, 1964
Bourgeois	3,828,367	Aug. 13, 1974
Buell	4,081,301	Mar. 28, 1978
Klasek et al. (Klasek)	4,293,367	Oct. 06, 1981
Teed	4,405,397	Sep. 20, 1983

Claims 10 through 16 and 21 stand rejected under 35 USC 103 as unpatentable over Klasek in view of the combined teachings of Buell, Penman, and Teed. Claims 17 and 18 stand rejected under the same statutory provision as unpatentable over the same combination of references, further taken in view of Bourgeois.

OPINION

We shall not sustain these rejections.

Initially, we consider the question whether the Penman reference is from a nonanalogous art. First, we find it clear that this reference is not within the field of appellants' endeavor. On the contrary, Penman relates to the art of carpet manufacture whereas appellants' field of endeavor is the art of manufacturing disposable diapers. Indeed, each of the patents issued to Klasek, Buell, Teed, and Bourgeois relates to the art of making diapers, as does appellants' specification disclosure. Penman, which stands apart, relates to the art of making carpets.

[1] Second, it is our judgment that Penman is not reasonably pertinent to the particular problem with which appellants were involved, i.e., the application of an elastic strip to a web in a curvilinear pattern. In determining this latter point, we have evaluated and weighed the Courtray declaration filed under Rule 132 wherein declarant sets forth reasons why the artisan "would not look to the carpet manufacturing process and equipment field to solve a problem in the application of elastic to a web in a curvilinear pattern". See Paper No. 15, page 1. We note that the examiner entered and considered the declaration (see Paper Nos. 18 and 22) but found same "not persuasive" because, according to the examiner, declarant merely offers his opinion on the art of carpet making. The examiner discounted that opinion because declarant is not established as an expert in that art. We disagree with the examiner's analysis. The examiner does not deny that declarant is skilled in the art of manufacturing diapers, although declarant does not claim to have the same level of skill in the art of making carpets. In this regard, we note that persons having ordinary skill "could not possibly be aware of every teaching in every art". See *In re Wood*, 559 F.2d 1032, 202 USPQ 171, 174 (CCPA 1979). Certainly, declarant expresses skepticism whether a person having ordinary skill in the art of manufacturing disposable diapers would consider the carpet manufacturing process and equipment filed as reasonably pertinent to the particular problem with which the appellants were involved. As stated in *In re Dow Chemical Company*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988), skepticism expressed by an expert in the art is entitled to fair evidentiary weight.

[2] We also find that the examiner's characterization of the problem in Paper No. 22, i.e., "the laminating of continuous running sheets utilizing a hot melt adhesive", is broader than the particular problem with which appellants were involved. Precise definition of the problem is important in determining whether a reference is from a nonanalogous art. Defining the problem too narrowly may result in excluding consideration of relevant prior art. By the same token, defining the problem too broadly, as done here, may result in considering prior art as "analogous" which is inconsistent with real world considerations. See *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985), vacated, 475 U.S. 809, 229 USPQ 478 (1986), aff'd on *1820 remand, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987).

Having applied the two-fold test for determining whether a reference is from a nonanalogous art, see *In re Wood*, supra, we hold that on the facts of this case the Penman reference constitutes nonanalogous art. It is therefore not available as a reference in evaluating the obviousness of appellants' claimed invention under 35 USC 103.

[3] Turning to a consideration of the Teed patent of record, we find that Teed discloses a method for manufacturing disposable diapers wherein elastic strips are applied in a straight line. This is illustrated in Figure 8, note rectilinear elastic strips (16) therein. Klasek, on the other hand, discloses a method for manufacturing disposable diapers wherein the elastic strips are applied in a curvilinear profile, and Klasek requires that the web and elastic be secured together by a pair of juxtaposed rolls acting in concert. See particularly Klasek, Figures 4 and 9. Certainly, Klasek's method involving a pair of rolls could be modified per the disclosure of Teed which appears to illustrate the use of a single roller. In our view, however, such proposed modification amounts to a hindsight reconstruction of the prior art patents in order to arrive at appellants' invention. Without having the benefit of appellants' disclosure, the artisan would view Klasek's pair of rolls as serving an important function in facilitating the application of elastic strips in a curvilinear profile. As discussed supra, the elastic strips in Teed are applied in a straight line and we disagree that the artisan would have found it obvious to substitute a single roller from Teed for a pair of rollers in Klasek, whose objective is to apply elastic strips in a curvilinear profile.

The mere fact that the prior art could be modified in the manner proposed by the examiner would not have made the modification obvious unless the prior art suggested the desirability of the modification. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) and cases cited therein. We have carefully reviewed the Klasek and Teed references in their entireties, and we find no express or implied suggestion in the collective teachings of these references which would have motivated the artisan to combine them in the manner proposed.

In conclusion, we hold that the Penman reference constitutes nonanalogous art and is therefore not available as a reference in evaluating the obviousness of appellants' claimed invention under 35 USC 103. With respect to the Teed patent of record, we conclude that Teed is not properly combinable with the "primary" reference to Klasek in the manner proposed by the examiner. Penman and Teed are essential to the examiner's case of obviousness. The examiner does not contend, nor do we find, that the combination of Klasek and Buell or the combined teachings of Klasek, Buell and Bourgeois are sufficient to establish the obviousness of appellants' claimed invention. Accordingly, the examiner's decision refusing to allow claims 10 through 18 and 21 is reversed.

REVERSED.

P.T.O. Bd.Pat.App. & Int.

7 U.S.P.Q.2d 1818